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| 10/667,826 | 09/22/2003 | Donald E. Weder | 8403.969 | 1010 |

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| EXAMINER |
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AFTERGUT, JEFF H

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| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,826

Applicant(s)

WEDER, DONALD E.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-22-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art in view of Weder et al '266 (U.S. Patent 4,292,266), Japanese Patent 50-6031 and Mearl Iridescent Films, General Information.

The admitted prior art taught that it was known at the time the invention was made to form artificial grass with various decorative effects and that the grass was utilized in baskets for decorative purposes. The grass material was formed from a laminate of an optical effect material and other layers. When making an artificial grass from these laminated materials, the admitted prior art taught that these laminates were not curled (or crimped with a preset curl therein). The admitted prior art failed to teach how one would have produced the decorative effects in the grass via a lamination operation wherein the laminate was provided with a preset curl and then cutting the laminate to form artificial grass. It should be noted that the admitted prior art did suggested that it was desirable to have a curled grass, however this was formed from a single sheet of extruded material and not a laminate of optical material and other plastic layers.

Weder et al '266 taught that it was known to have been desirable to include a curl in a decorative grass material. It should be noted that the process for forming the same

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failed to include lamination and additionally did not include an optical sheet of material laminated to another sheet material. However, the admitted prior art taught the formation of the artificial grass which included a laminate with optical material, the grass of the admitted prior art was not curled.

Japanese Patent '031 taught that it was known at the time the invention was made to form a laminate which included a preset curl therein by stretching one sheet of the material and laminating the stretched sheet of plastic material to another sheet of plastic material. The substrate after lamination was cut into ribbons and the ribbons were curled (with the application of heat) after the cutting operation in order to form a material which had the appearance of artificial grass. The reference failed to teach that one of the plastic sheets would have included optical material, however it clearly suggested that one desiring to imitate grass which was formed from a laminate of materials would have curled the same by provision of a preset curl in the laminate utilizing one of the techniques disclosed by applicant for forming the preset curl therein. The use of optical films to form laminates wherein the same was cut and would have been crinkled or curled to impart the desired decorative effects was known as suggested by Mearl Iridescent Films, General Information.

Mearl Iridescent Films, General Information taught that it was known at the time the invention was made to employ a film having optical properties in the manufacture of various items including but not limited to glitter and ribbons. The optical iridescent material was stated to have been suitable for lamination onto other layers in order to vary the optical effect provided. The reference additionally taught that the film would

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have suitably been converted into finished products employing a lamination operation as well as various cutting operations in order to form the finished end product. The reference made it clear that those concerned with manufacture of an optical effect in an end product from a plastic material would have readily appreciated that the Mearl iridescent films would have been useful materials used in the operation for manufacturing the end products, note that the admitted prior art suggested the use of optical effects for the decorative grasses. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the optical films of Mearl Iridescent Films, General Information in the process of making a decorative grass which was curled (as was known to have been desired as suggested by Weder '266) by providing a preset curl in the plastic laminated artificial grass material as taught by Japanese Patent 50-6031 when making a laminated decorative grass as taught by applicant's admitted prior art.

Regarding claims 2 and 10 those skilled in the art would have determined the optimum size of the grass and as evidenced by Weder et al '266, the specified sized were known per se in the art at the time the invention was made, see column 4, lines 56-68.

3. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with either one of Brodis or Johnson.

The references as set forth above in paragraph 2 suggested that the layers would have suitably been bonded together wherein the reference to Mearl Iridescent

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Films General Information suggested that the optical films would have suitably been bonded together with an adhesive material. The references failed to expressly state that the adhesive material employed would have included colored adhesive materials. However those skilled in the art at the time the invention was made were well aware of the use of colored adhesive materials useful for bonding layers of material together when making a decoration as evidenced by either one of Brodis or Johnson. More specifically, the applicant is referred to column 6, lines 26-28, 40-43, 48-49, and column 6, line 66-column 7, line 10 of Brodis and column 7, lines 41-47 of Johnson. Both references suggested that such colored adhesives would have been useful. It should be noted that Mearl Iridescent Films, General Information suggested that the optical sheets would have been printed with inks. The use of a colored adhesive or ink would have been viewed as a functional equivalent for applying colored decoration to the material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of either one of Brodis or Johnson in the operation of making a decorative grass where such coloring was desired in the process as set forth above in paragraph 2.

4. Claims 4-7, 12, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Weder et al '266 (U.S. Patent 4,292,266), Roberts et al and Mearl Iridescent Films, General Information.

The admitted prior art taught that it was known at the time the invention was made to form artificial grass with various decorative effects and that the grass was utilized in baskets for decorative purposes. The grass material was formed from a

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laminate of an optical effect material and other layers. When making an artificial grass from these laminated materials, the admitted prior art taught that these laminates were not curled (or crimped with a preset curl therein). The admitted prior art failed to teach how one would have produced the decorative effects in the grass via a lamination operation wherein the laminate was provided with a curl or crimp and then cutting the laminate to form artificial grass. It should be noted that the admitted prior art did suggested that it was desirable to have a curled grass, however this was formed from a single sheet of extruded material and not a laminate of optical material and other plastic layers.

Weder et al '266 taught that it was known to have been desirable to include a curl in a decorative grass material. It should be noted that the process for forming the same failed to include lamination and additionally did not include an optical sheet of material laminated to another sheet material. However, the admitted prior art taught the formation of the artificial grass which included a laminate with optical material, the grass of the admitted prior art was not curled or crimped prior to the cutting operation.

Roberts et al taught that it was known at the time the invention was made to laminate two plastic films together (wherein the plastic films would have included a metalized film in order to provide the desired decorative effects) and subsequently crimp the laminate and cut the same in order to form a tinsel material. More specifically, the reference to Roberts et al taught that two PVC films 9 and 11 were joined at roller 10 and then were crimped with a crimping device 3 which included rollers 5 and 7 which crimped the assembled plastic sheet 15. The reference taught that after the crimping

operation the sheet material was slit. The laminating and crimping operation in Roberts clearly employed the application of heat and pressure to the layers to join the same and form the crimps therein. Clearly, one skilled in the art of manufacturing a thin optical, decorative article would have understood that the same would have been shaped after the lamination operation and cut in order to provide a more effective optical display as suggested by Roberts et al.

Mearl Iridescent Films, General Information taught that it was known at the time the invention was made to employ a film having optical properties in the manufacture of various items including but not limited to glitter and ribbons. The optical iridescent material was stated to have been suitable for lamination onto other layers in order to vary the optical effect provided. The reference additionally taught that the film would have suitably been converted into finished products employing a lamination operation as well as various cutting operations in order to form the finished end product. The reference made it clear that those concerned with manufacture of an optical effect in an end product from a plastic material would have readily appreciated that the Mearl iridescent films would have been useful materials used in the operation for manufacturing the end products, note that the admitted prior art suggested the use of optical effects for the decorative grasses. The reference additionally suggested the crimping the films provided a different optical effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the optical films of Mearl Iridescent Films, General Information in the process of making a decorative grass which was curled or crimped (as was known to have been desired as suggested

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by Weder '266) by providing a curl or crimp in the plastic laminated artificial grass material as taught by Roberts et al when making a laminated decorative grass as taught by applicant's admitted prior art.

Regarding claims 5, 13, and 16 those skilled in the art would have determined the optimum size of the grass and as evidenced by Weder et al '266, the specified sized were known per se in the art at the time the invention was made, see column 4, lines 56-68. Regarding claim 12, the reference to Roberts et al clearly suggested the formation of a plurality of crimps in the material. Regarding claims 6 and 15, the applicant is advised that the formation of a curl in grass was known as suggested by Weder et al and applicant's admitted prior art. To form a curl instead of a crimp in the material would have been within the purview of the ordinary artisan and is taken as conventional in the art of making decorative articles as an alternative for formation of the specified crimps.

5. Claims 8, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 4 further taken with either one of Johnson or Brodis.

The references as set forth above in paragraph 4 suggested that the layers would have suitably been bonded together wherein the reference to Mearl Iridescent Films General Information suggested that the optical films would have suitably been bonded together with an adhesive material. The references failed to expressly state that the adhesive material employed would have included colored adhesive materials. However those skilled in the art at the time the invention was made were well aware of

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the use of colored adhesive materials useful for bonding layers of material together when making a decoration as evidenced by either one of Brodis or Johnson. More specifically, the applicant is referred to column 6, lines 26-28, 40-43, 48-49, and column 6, line 66-column 7, line 10 of Brodis and column 7, lines 41-47 of Johnson. Both references suggested that such colored adhesives would have been useful. It should be noted that Mearl Iridescent Films, General Information suggested that the optical sheets would have been printed with inks. The use of a colored adhesive or ink would have been viewed as a functional equivalent for applying colored decoration to the material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of either one of Brodis or Johnson in the operation of making a decorative glass where such coloring was desired in the process as set forth above in paragraph 4.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,891,286. Although the conflicting claims are not identical, they are not patentably distinct from each other because the previously patented claims relate to a species of invention where here the generic invention is recited. Note that the preset curl was established in the earlier patent via the stretching operation. It should be noted that practice of the claimed method of the earlier patent would have necessarily produced the same product as recited.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
November 22, 2005